



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,879	02/24/2004	Hirokazu Sawada	Q78018	8674

23373 7590 11/08/2005
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

GILLIAM, BARBARA LEE

ART UNIT PAPER NUMBER

1752

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,879

Applicant(s)

SAWADA ET AL.

Examiner

Barbara L. Gilliam

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/19/2005 & 8/25/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/19/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed August 25, 2005 has been entered and fully considered.
2. Claims 1-21 are pending.
3. The claims are "product-by-process" claims. Applicant is reminded of MPEP 2113. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on July 19, 2005 was filed after the mailing date of the Non-Final Office Action on May 25, 2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawada et al. (JP 200-037965).

a. Sawada et al. teach a lithographic printing plate substrate that is subjected to electrochemical roughening at the surface wherein the substrate contains 0.05 – 0.5 wt% Fe, 0.03 -0.15 wt % Si, 0.006-0.03 wt% Cu, 0.010-0.040 wt% Ti (abstract). Sawada et al. is silent with respect to the surface area ratio and steepness of the aluminum support, however the aluminum support contains iron, silicon, copper and titanium in specific amounts, which are consistent with the presently claimed aluminum support. Further the aluminum support is subjected to the same surface treatments as the presently claimed lithographic printing plate support. For this reason, it is the Examiner's position the presensitized plate aluminum support of Sawada et al. inherently has a steepness and surface area ratio consistent with the presently claimed support. MPEP 2112 – 2112.02.

7. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishio et al. (EP 853 132 A1).

a. The presensitized planographic printing plate of Nishio et al. comprises an aluminum alloy support and a light sensitive layer thereon (abstract). The aluminum alloy support, containing not more than 0.25 wt% of Si, not more than 0.40 wt% of Fe not more than 0.05 wt % of Cu, not more than 0.03 wt% of Ti, meets the present limitations for the same. Nishio et al. is silent with respect to the surface area ratio and steepness of the aluminum support, however the aluminum support contains iron,

Art Unit: 1752

silicon, copper and titanium in specific amounts, which are consistent with the presently claimed aluminum support. Further the aluminum support is subjected to the same surface treatments as the presently claimed lithographic printing plate support. For this reason, it is the Examiner's position the presensitized plate aluminum support of Sawada et al. inherently has a steepness and surface area ratio consistent with the presently claimed support. MPEP 2112 – 2112.02.

Response to Arguments

8. In light of Applicant's perfected priority date and arguments, see page 2, filed August 25, 2005, with respect to the rejection of claims 1-21 under 35 USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection are made in view of EP 1 138 519 A2, JP and.

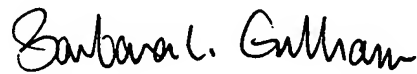
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1752

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
November 3, 2005